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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,550	10/01/2003	R. J. Baker	M4065.0451/P451-B	5735
24998	7590	07/08/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L Street, NW Washington, DC 20037			TRAN, ANDREW Q	
			ART UNIT	PAPER NUMBER
			2824	

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/674,550

**Applicant(s)**

BAKER, R. J.

**Examiner**

Andrew Q. Tran

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-52 is/are pending in the application.
- 4a) Of the above claim(s) 34-37 and 40-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-33, 38, 39 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Information Disclosure Statements (IDS) of 10/01/2003, 09/10/2004 and 06/21/2005.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I invention (claims 28-33, 38-39 and 52) in the reply filed on April 27, 2005 is acknowledged.

Claims 34-37 and 40-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 27, 2005.

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings currently in the application are informal and of poor quality for printing purposes. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

At page 14, line 3, "Figure 9" should be changed to --Figure 7--.

Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 38-39 and 52 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 5-6 and 23 of prior U.S. Patent No. 6,504,750 to Baker on January 07, 2003 (hereafter "Baker"). This is a double patenting rejection.

Note that examined claim 52 recites "a memory device" (line 7) and reference claim 23 recites "a magnetic random access memory" (line 8) and thus claiming the same invention, unless a specific structure of a magnetic memory cell is present in the claims, besides the "resistive element", to differentiate.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-6 and 23-24 of U.S. Patent No. 6,504,750

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to Baker on January 07, 2003 (hereafter "Baker"). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because, for example, reference claim 5 recites a method of determining a resistance value (ref. clm. 5, ln. 1) comprising the steps of : cyclically discharging a capacitance through a resistance (ref. clm. 5, ln. 4); determining a duty cycle of a recharging signal for the capacitance; and obtaining the resistance value from the duty cycle of the recharging signal (ref. clm. 5, ln. 10-12). As to examined claim 31, see ref. clm. 5, ln. 3. As to examined claims 32 and 33, see ref. clm. 23, ln. 8, or ref. clm. 24, ln. 10.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-33, 38-39 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 28, line 3, the term "cyclically discharging" is unclear. Further clarification is required. Also in claim 28, line 4, the step of "determining a duty cycle of a recharging signal" is insufficiently disclosed which requires further clarification. It is unclear from the specification which element corresponds to "a recharge signal" (claim 28, line 4).

In claim 38, line 7-8, the step “determining the resistance from the number of recharging pulses generated during a predetermined time period” is unclear. It is not clearly understood how the number of recharging pulses determines the resistance of the memory cell. In claim 39, line 2, the terms “the capacitor” and “the resistor” lack proper antecedent bases. It is suggested to change said terms to --the capacitance-- and --the resistance--, respectively. Further in claim 39, line 2, the term “a substantially constant current” is indefinite.

Claim 52 is incomplete as failing to recite the interconnections between claimed elements : “a controlled voltage supply” (line 2), “an electronic charge reservoir” (line 3), “a current source” (line 4), or “a pulse counter” (line 5). For example, the “pulse counter” (claim 52, line 5) is not connected to other claimed elements. In addition, in claim 52, numerous elements are indefinite because it is unclear what is being recited. Examples of such unclear recitations are : “a controlled voltage supply” (line 2), “an electronic charge reservoir” (line 3), “a current source” (line 4), or “a pulse counter” (line 5). It is suggested that Applicant point out which elements or features described in Figure 4 that correspond to these unclear recitations. In claim 52, line 6-8, the terms “an element” and “a resistive element” incur double inclusion of elements because it is unclear whether said terms refer to same or different elements. In claim 52, penultimate line, the phrase “the contents of the pulse counter” is indefinite. What is meant by “contents”? In claim 52, last line, “the memory cell” lacks proper antecedent basis.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Forbat et al. (US Pat. 3,979,740) describes a monitoring system.

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Reed et al. (US Pat. 4,450,387) describes a CRT with internal thermionic valve for high voltage control.

Muggli et al. (US Pat. 4,559,453) describes a smoke detector with a radiation source operated in a pulse-like or intermittent mode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Q. Tran whose telephone number is (571) 272-1885. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard T. Elms can be reached on (571) 272-1869. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Andrew Q. Tran  
Primary Examiner  
Art Unit 2824

at  
July 05, 2005